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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,514	11/02/2000	Jeffry Jovan Philyaw	PHLY-25,509	6936
25883	7590	02/10/2005	EXAMINER	
HOWISON & ARNOTT, L.L.P. P.O. BOX 741715 DALLAS, TX 75374-1715			POLLACK, MELVIN H	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/705,514

Applicant(s)

PHILYAW, JEFFRY JOVAN

Examiner

Melvin H Pollack

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/10/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-11 and 13-20 have been considered but are moot in view of the new ground(s) of rejection.
2. In the response to the last office action, the applicant changed the scope of the claims by adding several limitations to the single independent claim. As a result, a final amendment is necessitated even if the examiner provides a new art rejection. The examiner acknowledges that no new matter has been added by this amendment.
3. The applicant has failed to respond or provide evidence regarding priority. Therefore, the effective filing date remains 11/2/00 and is made final.
4. As per the IDS, the examiner has considered the new IDS. The foreign patent JP 10188140 A has not been considered because there is no English translation of at least the abstract or summary and therefore the relevance cannot be judged by the examiner. The foreign patents F1-F9 have not been considered because no copies have been provided.
5. The objection to the specification has been withdrawn in light of the amendment.
6. The objection to the abstract has been withdrawn in light of the amendment.
7. The original 112 rejections have been handled as follows, based upon the amendment and remarks provided: The claims 1-20 rejection regarding "launch signal" has been withdrawn except for claim 4, which still uses launch signal, and the rejection has been modified to reflect this. The claims 5, 6, and 31 rejection regarding "substantial" has been withdrawn. The claims 21-32 rejection has been withdrawn since these claims were cancelled. The rejection regarding

Art Unit: 2145

claims 11-16 has been modified to reflect new issues, as described below, with claims 12, 15, and 16 rejections withdrawn and claims 11, 13, and 14 rejections modified.

8. The original art rejections have been withdrawn, and new art rejections will be provided herein.

9. The applicant recites that part of the inventive concept is that "The control signal is prevented from being transmitted prior to the transmission of the animation." This limitation is present in only one embodiment. In other embodiments, the control signal is transmitted at the same time or after the transmission of the animation.

Information Disclosure Statement

10. The information disclosure statement filed 9/10/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Copies of Foreign Patents F1-F9 are missing.

11. The information disclosure statement filed 9/10/04 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. Foreign patent F11 is missing a translated portion to explain the reference, such as a summary or translated abstract.

Claim Rejections - 35 USC § 112

Art Unit: 2145

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 4, 11, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claim 4 recites the limitation "launch signal" in claim 1. There is insufficient antecedent basis for this limitation in the claim. For the purposes of examination, the examiner will assume that the applicant meant control signal.

15. Claims 11, 13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the scope and definition of sound signals. The claims as currently amended are drawn to a sound signal comprising the control signal that is inaudible to the human ear. But the related remarks section (P. 10, Para 4) states that "Claims 11-16... have been amended... As to the sound, although the computer receives the sound, the sound that is picked up is in the range that is audible to the human. Since it is broadcast and can be output by a speaker, the frequency range is important in this claim." Because of this disparity between the claims and the current record, it is unclear if the sound signal is an auditory cue, a "sound-based" or "sound-transmitted" command, or some combination thereof. For the purposes of examination, the examiner will assume that the claims comprise a sound-based control signal.

Claim Rejections - 35 USC § 102

Art Unit: 2145

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claims 1-7, 16-18, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Stern et al. (6,591,247).

18. For claim 1, Stern teaches a method (abstract) for facilitating computer based access (col. 1, line 30 – col. 4, line 30) to a location (Fig. 2, #30c) on a network (Fig. 1, #10) by a consumer witnessing a presentation broadcast to the consumer (col. 3, lines 50-55), comprising the steps of:

- a. Providing a visual cue during the presentation apparent to the consumer (col. 6, lines 35-45) and indicative of a relationship between the visual cue and the presence of the location on the network (col. 6, lines 45-60); and
- b. Releasing a control signal (col. 8, line 65 – col. 9, line 10) in association with the visual cue during the broadcast (Fig. 4, #450) wherein a computer having an input device responsive to the control signal such that the control signal can both be recognized by the input device and control information contained in the control signal can be extracted therefrom (col. 17; lines 5-50) to enable and control the computer to access the location on the network upon the appearance of the visual cue and receipt of the control signal during the broadcast of the presentation, which control is facilitated from the broadcast with no user intervention (col. 9, lines 50-60).

Art Unit: 2145

19. For claim 2, Stern teaches attracting the consumer's attention to the computer for interacting with the location on the network in association with the access thereto (col. 17, lines 5-10).

20. For claim 3, Stern teaches that the step of providing a visual cue precedes the step of releasing the control signal (col. 8, lines 50-65).

21. For claim 4, Stern teaches that the step of releasing the control signal precedes the step of providing a visual cue (col. 20, line 66 – col. 21, line 7).

22. For claim 5, Stern teaches that the steps of providing the visual cue and releasing the control signal occur simultaneously (col. 16, lines 10-20).

23. For claim 6, Stern teaches that the steps of providing the visual cue and releasing the control signal occur within a defined interval of time (col. 9, lines 55-60).

24. For claim 7, Stern teaches animating the visual cue during its appearance wherein the animation is accompanied by the control signal (col. 12, lines 34-36).

25. For claim 16, Stern teaches that the visual cue (col. 25, lines 33-40) includes a logo (bumper).

26. For claim 17, Stern teaches that the presentation witnessed by the consumer includes a program having audio and video content (col. 17, lines 25-40).

27. For claim 18, Stern teaches that the presentation witnessed by the consumer includes a broadcast communication having audio and video content (col. 25, lines 5-59).

28. For claim 20, Stern teaches that the presentation includes a recorded portion (col. 12, lines 20-25).

Claim Rejections - 35 USC § 103

Art Unit: 2145

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern as applied to claims 1, 7 above, and further in view of Portuesi (5,987,507).

31. For claim 8, Stern does not expressly disclose detaching one or more moving segments from a stationary portion of the visual cue, and traversing a path with each detached segment about the stationary portion of the visual cue to a predetermined position adjacent thereto.

Portuesi teaches a method (abstract) of displaying visual cues during a broadcast which may then be activated to assist in gaining remote information (col. 1, line 15 – col. 4, line 5) and in which this limitation is further taught (col. 6, lines 20-45). At the time the invention was made, one of ordinary skill in the art would have added the Portuesi input method to Stern in order to ensure easier selection of data (col. 3, lines 20-30).

32. For claim 9, Stern and Portuesi do not expressly disclose that the stationary portion of the visual cue forms an alphanumeric character and the moving segment resembles a punctuation mark. Examiner takes Official Notice (see MPEP § 2144.03) that the particular design of the visual cue mentioned above, in a computer networking environment, was well known in the art at the time the invention was made. That is, it has already been shown that a visual cue is made of a stationary picture and a moving picture, and the examiner concludes that it would be trivial and obvious to replace one picture with another. Furthermore, this particular display adds no functionality over a different type of display in which part of the system moves. At the time the

Art Unit: 2145

invention was made, one of ordinary skill in the art would have used the aforementioned pictures for aesthetic design purposes.

33. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)."

Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

34. For claim 10, Stern does not expressly disclose that the stationary portion of the visual cue forms an iconic figure and the moving segment resembles an element of said iconic figure. *Porteusi* teaches this limitation (Fig. 4, #40). At the time the invention was made, one of ordinary skill in the art would have added this separation to enable movement of visual cues (col. 3, lines 43-45).

35. Claims 11, 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern as applied to claim 1 above, and further in view of *Jensen et al.* (6,421,445).

36. For claim 11, Stern does not expressly disclose the step of releasing a control signal comprises providing a sound signal as a part of the broadcast having a recognizable characteristic that is identifiable each time it occurs by the input device on the computer, the sound signal comprising the control signal. *Jensen* teaches a method (see abstract) for a broadcast system

Art Unit: 2145

(col. 1, lines 18-21) in which command signals are embedded in audio signals (col. 2, lines 6-9).

At the time the invention was made, one of ordinary skill in the art would have used Jensen in a Stern system in order to fulfill a variety of broadcasting purposes, such as tracking of ratings (col. 31, lines 44-45) and commercials (col. 33, lines 25-30).

37. For claim 13, Stern does not expressly disclose that the frequency of the sound signal is outside the range of human hearing. Jensen teaches this limitation (col. 2, lines 10-20). At the time the invention was made, one of ordinary skill in the art would have made the codes inaudible so as not to intrude on other audible tones (col. 1, lines 10-20 and 38-48).

38. For claim 14, Stern does not expressly disclose that the intensity of the sound signal is below the threshold of human hearing. Jensen teaches this limitation (col. 2, lines 20-25; signal amplitude). At the time the invention was made, one of ordinary skill in the art would have made the codes inaudible so as not to intrude on other audible tones (col. 1, lines 10-20 and 38-48).

39. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stern as applied to claim 1 above, and further in view of Itoh et al. (6,487,719).

40. For claim 15, Portuesi does not expressly disclose the step of releasing a control signal comprises the step of providing a light signal having a recognizable characteristic that is identifiable each time it occurs by the input device on the computer, the light signal comprising the control signal. Itoh teaches a method (see abstract) in which a monitoring of a broadcast (col. 1, lines 5-15) is achieved through light control signals (col. 3, lines 27-54). At the time the

Art Unit: 2145

invention was made, one of ordinary skill in the art would have used Itoh to perform channel monitoring (col. 3, lines 1-27).

41. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stern as applied to claim 1 above, and further in view of Ludwig et al. (6,237,025).

42. For claim 19, Stern does not expressly disclose that the presentation witnessed by the consumer includes a live presentation. Ludwig teaches a method (see abstract) of videoconferencing (col. 21, lines 45-55) in which active URLs may be embedded into the presentation (Fig. 30). At the time the invention was made, one of ordinary skill in the art would have combined the two inventions in order to allow real-time information to be transmitted (col. 4, lines 55-65).

Conclusion

43. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2145

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (571) 272-3887.

The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
26 January 2005

V. Martin Wallace
V. Martin Wallace
Supervisory Patent Examiner